



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE

1. Application No.	2. Filing Date	3. Inventor(s)	4. Attorney(s)	5. Title
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CONNOLLY BOVE LODGE & HUTZ LLP
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1990 M STREET NW
WASHINGTON, DC 20036-8428

6. Class(es)

7. Priority

8. Inventor(s)	9. Attorney(s)
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10. Date

DATE MAILED

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 C.F.R. 1.136(a), but a reply must be filed after SIX (6) MONTHS from the mailing date of this communication.

A time period for reply has first been established by statute, and then by regulation, as not more than thirty (30) days will be considered timely. If NO period for reply is determined above, the period for reply, determined by regulation, is SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the time period extended by regulation will result in the case becoming ABANDONED, 37 C.F.R. 1.136. Any reply received by the Office later than the expiration of the time period for reply, even if timely, may produce an adjusted patent term adjustment. See 37 C.F.R. 1.104(b).

Status

- ☒ Responsive to communication(s) filed on 12-26-94
☒ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 O.D. 11, 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 5, 6, 7-11 and 13-16
Of the above claim(s)

is/are pending in the application.

is/are withdrawn from consideration.

Claim(s)

is/are allowed.

- ☒ Claim(s) 5, 6, 7-11 and 13-16

is/are rejected.

Claim(s)

is/are objected to.

Claim(s)

are subject to restriction or election requirement

Application Papers

The proposed drawing correction, filed on _____, is _____ approved _____ disapproved.

The drawing(s) filed on _____, is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All Some* None of the:

- ☒ Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. _____.

Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s).

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other

Office Action Summary

Art Unit 1714

The following is a quotation of the second paragraph of 35 U.S.C. 112

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claim is dependent on the canceled claim 3, and thus indefinite

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made

Claims 5, 6, 8-11 and 13-15 are rejected under 35 U.S.C. 103(a) as obvious over Yamamori et al (US 5,199,977) alone, or in view of Codolar et al (US 6,248,806)

Rejection is maintained for reson of record and following

The Examples 1 and 2 of table 1 recite a better antifouling property than Comparative examples having a high Tg, degree of polymerization and acid value. However, said (high) Tg and degree of polymerization are not the controlling parameters in claims, and the specification does not show any value regarding said high Tg and degree of polymerization for said comparative examples. As a matter of facts, nothing is recited with respect to said (high) Tg

Art Unit 1714

(except claim 14) and degree of polymerization in claims. With respect to an acid value, only claims 6, 14 and 15 recite an acid value. Thus, any comparison has little probative value.

Applicant states that an acrylic resin with a side chain of a monobasic acid having a diterpenoid hydrocarbon skeleton has an improved antifouling property over a resin with naphthethenic acid as seen in examples 1, 2, 18, 20 and comparative example 5 (there is table 2, not 5). However, any comparison is non-conclusive since the main backbone polymers (and possibly Mn, Tg and acid value) and other components are different from each other in said examples. Only variable should be an acid in order to have a fair comparison. Also, a comparison must be based on the closest prior art and not on applicant's own choice. Thus, a comparison of the example 7 of Yamamori et al and said example 7 with an abietic acid would make more sense.

Besides, applicant teaches "--- the monobasic acid is not particularly restricted but from the standpoint of long-term antifouling effect and crack resistance, it is preferred to us a monobasic cyclic organic acid. The monobasic cyclic organic acid mention just above is not particularly restricted but may for example be one having a cycloalkyl moiety, such as naphthethenic acid" at page 8, lines 17-23. Thus, said naphthethenic acid is one of applicant's preferred acid and examples 18 and 20 containing said naphthethenic acid are taught as the inventive example in table 2. Thus, applicant assertion that said examples 18 and 20 (22 months) are worse in the long-term antifouling effect than examples 1 and 2 (24 months) has little probative value. Applicant did not realize a monobasic acid having a diterpenoid hydrocarbon skeleton is superior to other cyclic organic acids at the time of the invention.

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Claims 5, 6, 8-11 and 13-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 342 276.

Rejection is maintained for reason of record and above.

Rejection based on Yamamori et al (US 4,774,080 or EP 0 204 456) is withdrawn since it is similar to above rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY February 10, 2003

